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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,848	08/14/2000	Jay Paul Drummond	D-1077+17	9773
28995	7590	10/12/2004	EXAMINER	
RALPH E. JOCKE 231 SOUTH BROADWAY MEDINA, OH 44256			ELISCA, PIERRE E	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/638,848

Applicant(s)

DRUMMOND ET AL. 

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27, 29, 30 and 34-38 is/are allowed.
- 6) ☒ Claim(s) 1-26, 28, 31-33 and 39-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is in response to Applicant's amendment, filed on 06/23/2004.
2. Claims 1-43 are pending.

Allowable Subject Matter

3. Claims 27, 29, 30, 34, 35, 36, 37 and 38 are allowed over the prior art of record.
4. The rejection to claims 1-26, 28, 31-33, 39-43 under 35 U.S.C. 103 (a) as being unpatentable over Wagner in view of Zeanah as set forth in the Office action mailed on 03/25/2004 is maintained.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-11, 28 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (U.S. Pat. No. 5,742,845) in view of Zeanah et al. (U.S. Pat. No. 5,933,816).

As per claims 1, 4, 5, 6, 7, 28 and 40-43 Wagner substantially discloses an ATM or POS data transaction system, comprising:

providing a first , wherein the first icon corresponds to a first ATM object (see., Wagner, abstract, col 1, lines 14-67, col 2, lines 4-63, col 4, lines 1-67, please note that each terminal or computer has a icon). As per claim 40, Wagner also discloses wherein said providing a visual pathway icons in the abstract, col 1, lines 14-67, col 2, lines 4-63, col 4, lines 1-67. Please note that each terminal or POS or computer or server is capable of viewing or visually display programming or items or application program. It is to be noted that Wagner fails to explicitly disclose a second icon corresponds to a second ATM. However, Zeanah discloses a second icon corresponds to a second ATM object (see., Zeanah, abstract, col 5, lines 39-60, it is obvious to realize each computer or terminal has a icon). Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the ATM/POS based electronic mail system of Wagner with the ATM of Zeanah because this would permit ATM users to transmit messages to each other.

As per claim 2, Wagner discloses the claimed method of storing in a memory a plurality of institutions that are representative of the association visually represented in the work place (see., Wagner, abstract, col 2, lines 24-63).

As per claim 3, Wagner discloses the claimed method of performing a transaction with an automated transaction machine responsive to the instructions (see., abstract, col 1, lines 14-67, col 4, lines 1-34).

As per claim 8, Wagner discloses the claimed method wherein in step (f) the function includes having a transaction function device perform an operation (see., abstract, col 1, lines 14-67, col 4, lines 1-34).

As per claims 9, 10, 11, Wagner discloses the claimed method wherein the transaction function device includes a cash dispenser device (see., Wagner, abstract, col 1, lines 14-67, col 4, lines 1-34, ATM dispenses cash).

7. Claims 12-26, 31-33 and 39 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Wagner in view of Zeanah.

As per claims 12-26, 31-33 and 39 Wagner disclose the claimed limitations as stated in claims 7, 5, 3 and 1 above. It is to be noted that Wagner fails to disclose a third ATM. However, Zeanah discloses a third ATM see., Zeanah, abstract). Furthermore, Zeanah discloses a navigation shell component 82, and a web browser remote device or web page, and a delivery capabilities that include the HTML level (see., col 12, lines 41-67, col 19, lines 18-34). It is obvious to recognize that the teachings of Wagner and Zeanah can also include a fourth ATM. Therefore, it would have been obvious to a person of

ordinary skill in the art at the time the invention was made to combine the ATM systems of Wagner with the third ATM of Zeanah because this would permit ATM users to transmit messages to each other.

RESPONSE TO ARGUMENTS

8. Applicant's arguments filed on 12/08/2003 have been fully considered but they are not persuasive. Necessitated by amendment filed on 06/23/2004.

REMARKS

9. In response to Applicant's arguments, Applicant argues that:

a. there is no teaching, suggestion, or motivation cited so as to produce the recited invention. The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In *re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21

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USPQ2d 1941 (Fed. Cir. 1992). See also *In re Eli Lilli & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter); and *Es parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to *Ex parte Levengood*, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, *In re Keller*, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. *In re Soli*, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

b. Applicant also argues that the prior art of record (*Wagner*) taken alone or in combination fails to disclose "programming". However, the Examiner respectfully disagrees since *Wagner* discloses this limitation in the abstract, col 5, lines 35-67, specifically wherein said the server which converts protocol statements communicated between the server and I/O devices to application program (or programming or software).

- c. " neither Wagner nor Zeanah taken alone or in combination teach or suggest programming an automated transaction machine. As indicated above, it is believed that Wagner discloses this limitation in col 1, lines 1-34, col 2, lines 1-47, col 4, lines 1-34.
- d. As per claim 40, Wagner also discloses wherein said providing a visual pathway icons in the abstract, col 1, lines 14-67, col 2, lines 4-63, col 4, lines 1-67. Please note that each terminal or POS or computer or server is capable of viewing or visually display programming or items or application program.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Pierre Eddy Elisca

Primary Patent Examiner

October 05, 2004